

Restriction Requirement Under 35 U.S.C. § 121

The Examiner has required an election under 35 U.S.C. § 121 of one of the following inventions:

- I. Claims 1-2, 5-7, 10-11, 14-15, 18-19, 22-23 and 26-42, drawn to a method of inducing immunity, classified in class 424, subclass 184.1;
- II. Claims 3, 8, 12, 16, 20, 24 and 26-43, drawn to methods treating an infectious disease, classified in class 424, subclass 184.1;
- III. Claims 3, 8, 12, 16, 20, 24, 26-43 and 45, drawn to methods of preventing infectious disease, classified in class 424, subclass 184.1;
- IV. Claims 4, 9, 13, 17, 21, 25-42, 44 and 46 drawn to methods of treating cancer, classified in class 424, subclass 184.1;
- V. Claims 4, 9, 13, 17, 21, 25-42, 44 and 47, drawn to methods of preventing cancer, classified in class 424, subclass 184.1;
- VI. Claims 48-54, drawn to kits, classified in class 435, subclass 975;
- VII. Claims 55-56, 59-60, 63-64 and 67-70, drawn to methods of inducing an immune response with APCs, classified in class 424, subclass 93.1;
- VIII. Claims 57, 61, 65 and 67-71, drawn to treatment of infectious disease with APCs, classified in class 424, subclass 93.1;
- IX. Claims 57, 61, 65 and 67-71, drawn to prevention of infectious disease with APCs, classified in class 424, subclass 93.1;
- X. Claims 58, 62, 66-70 and 72, drawn to treatment of cancer with APCs, classified in class 424, subclass 93.1;

- XI. Claims 58, 62, 66-70 and 72, drawn to prevention of cancer with APCs, classified in class 424, subclass 93.1;
- XII. Claims 73-74 and 77-78, drawn to methods of producing an immune response with both heat shock proteins and APCs, classified in class 424, subclass 93.3;
- XIII. Claims 75 and 77-78, drawn to treating an infectious disease with both heat shock proteins and APCs, classified in class 424, subclass 93.3;
- XIV. Claims 75 and 77-78, drawn to preventing an infectious disease with both heat shock proteins and APCs, classified in class 424, subclass 93.3;
- XV. Claims 76-78, drawn to methods of treating cancer with both heat shock proteins and APCs, classified in class 424, subclass 93.3;
- XVI. Claims 76-78, drawn to methods of preventing cancer with both heat shock proteins and APCs, classified in class 424, subclass 93.3; and
- XVII. Claims 79-81, drawn to methods of improving treatment, classified in class 424, subclass 184.1.

The Examiner contends that each of Groups I-XVII are distinct from the other Groups.

In response, Applicant hereby provisionally elects the invention of Group IV, claims 4, 9, 13, 17, 21, 25-42, 44 and 46 drawn to methods of treating cancer, classified in class 424, subclass 184.1, with traverse.

With respect to the division of the application into 17 groups of claims, Applicant respectfully traverses the restriction requirement. Specifically, Applicant requests a modification of the requirement so that Group IV (Claims 4, 9, 13, 17, 21, 25-42, 44 and 46) and Group V (Claims 4, 9, 13, 17, 21, 25-42, 44 and 47) be combined, and examined

together in the instant application. For the reasons which are detailed below, the subject matter of these claims merits examination in a single application.

Group IV and Group V are directed to cancer methods. Specifically, Group IV relates to methods of treating cancer and Group V relates to methods of preventing cancer.

In view of the common feature in Groups IV and V, namely cancer methods, Applicant submits that a search for art relevant to one group, Group IV, would necessarily overlap and identify art relevant to the other group, Group V.

Accordingly, Applicant submits that to search the subject matter of Groups IV and V together would not be a serious burden on the Examiner. Even assuming *arguendo* that the methods were to be considered distinct inventions, Applicant asserts that, pursuant to M.P.E.P. § 803, the subject matter of Claims 4, 9, 13, 17, 21, 25-42, 44 and 46-47 can be examined together in a single application without imposing a serious burden to the Examiner. The M.P.E.P. § 803 (Eighth Edition, August 2001) states:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

Moreover, Applicant respectfully points out that the subject matter of Groups IV and V are in the same class and subclass. Thus, in view of M.P.E.P. § 803, Groups IV and V should be examined together, since such would not be a "serious burden" on the Examiner.

Applicant respectfully requests the Examiner to place Claims 4, 9, 13, 17, 21, 25-42, 44 and 46-47 within a single group.

Attorneys for Applicant retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

CONCLUSION

Applicant respectfully requests that the present amendments and remarks be entered and made of record in the instant application. An early allowance of the application is earnestly requested. If any issues remain in connection herewith, the Examiner is respectfully invited to telephone the undersigned to discuss the same.

Respectfully submitted,

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EXHIBIT A

MARKED-UP VERSION OF CLAIMS AS AMENDED HEREIN

U.S. Patent Application No. 09/693,643

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26. The method according to claim [1, 2, 3, or] 4 wherein the heat shock protein is administered before the administration of the vaccine composition.

27. The method according to claim [1, 2, 3, or] 4 wherein the heat shock protein preparation is administered concurrently with the administration of the vaccine composition.

28. The method according to claim [1, 2, 3, or] 4 wherein the heat shock protein is preparation administered after the administration of the vaccine composition.

29. The method according to claim [6, 7, 8, or] 9 wherein the heat shock protein preparation is administered before the administration of the vaccine composition.

30. The method according to claim [6, 7, 8, or] 9 wherein the heat shock protein preparation is administered concurrently with the administration of the vaccine composition.

31. The method according to claim [6, 7, 8, or] 9 wherein the heat shock protein is administered after the administration of the vaccine composition.

32. The method according to claim [10, 11, 12, or] 13 wherein the heat shock protein is administered before the administration of the vaccine composition.

33. The method according to claim [10, 11, 12, or] 13 wherein the heat shock protein is administered concurrently with the administration of the vaccine composition.

34. The method according to claim [10, 11, 12, or] 13 wherein the heat shock protein is administered after the administration of the vaccine composition.

35. The method according to claim [14, 15, 16, or] 17 wherein the heat shock protein is administered before the administration of the vaccine composition.

36. The method according to claim [14, 15, 16, or] 17 wherein the heat shock protein is administered concurrently with the administration of the vaccine composition.

37. The method according to claim [14, 15, 16, or] 17 wherein the heat shock protein is administered after the administration of the vaccine composition.

38. The method according to claim [18, 19, 20, or] 21 wherein the heat shock protein preparation is administered before the administration of the vaccine composition.

39. The method according to claim [18, 19, 20, or] 21 wherein the heat shock protein preparation is administered concurrently with the administration of the vaccine composition.

40. The method according to claim [18, 19, 20, or] 21 wherein the heat shock protein is administered after the administration of the vaccine composition.

41. The method according to claim [18, 19, 20, or] 21 wherein the heat shock protein preparation and the vaccine composition are both administered on the same day.

42. The method of claim [1, 2, 3,] 4 [5, 22, 23, 24,] or 25 wherein the vaccine composition is a live vaccine, an attenuated vaccine, a subunit vaccine, a DNA vaccine, or a RNA vaccine.